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PO BOX 7068			ERB, NATHAN		
PASADENA, CA 91109-7068			ART UNIT	PAPER NUMBER	
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SHORTENED STATUTORY	PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Applicati	ion No.	Applicant(s)				
Office Action Summary		09/938,1	17	OGG, CRAIG L.	OGG, CRAIG L.			
		Examine	r	Art Unit				
		Nathan E		3628				
Period fo	The MAILING DATE of this communic r Reply	cation appears on th	e cover sheet	t with the correspondence ac	ddress			
WHIC - Exter after - If NO - Failui Any r	CORTENED STATUTORY PERIOD FOR HEVER IS LONGER, FROM THE MANSIONS of time may be available under the provisions of SIX (6) MONTHS from the mailing date of this communication for reply is specified above, the maximum state to reply within the set or extended period for reply eply received by the Office later than three months afted patent term adjustment. See 37 CFR 1.704(b).	AILING DATE OF THE STATE OF THE	HIS COMMU vent, however, may vill expire SIX (6) N plication to become	NICATION. y a reply be timely filed MONTHS from the mailing date of this of a BANDONED (35 U.S.C. § 133).				
Status								
1)	Responsive to communication(s) filed	d on .						
′=	•	b) This action is	non-final.					
3) 🗌								
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Dispositi	on of Claims							
4)🖂	4) Claim(s) 1,4,5 and 8-12 is/are pending in the application.							
	4a) Of the above claim(s) is/are withdrawn from consideration.							
5)	5) Claim(s) is/are allowed.							
6)⊠	6)⊠ Claim(s) <u>1,4,5 and 8-12</u> is/are rejected.							
• —	7)⊠ Claim(s) <u>1,4,8-10 and 12</u> is/are objected to.							
8) Claim(s) are subject to restriction and/or election requirement.								
Applicati	on Papers							
9) The specification is objected to by the Examiner.								
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.								
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).								
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).								
11)	The oath or declaration is objected to	by the Examiner. N	lote the attac	hed Office Action or form P	10-152.			
Priority ι	ınder 35 U.S.C. § 119							
 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☐ All b) ☐ Some * c) ☐ None of: 1. ☐ Certified copies of the priority documents have been received. 								
	2. Certified copies of the priority documents have been received in Application No							
3. Copies of the certified copies of the priority documents have been received in this National Stage								
application from the International Bureau (PCT Rule 17.2(a)).								
* See the attached detailed Office action for a list of the certified copies not received.								
Attachmen	t(s)							
1) Notic	e of References Cited (PTO-892)			ew Summary (PTO-413)				
3) 🔲 Inform	e of Draftsperson's Patent Drawing Review (P nation Disclosure Statement(s) (PTO/SB/08) r No(s)/Mail Date	TO-948)		No(s)/Mail Date of Informal Patent Application				

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 18, 2006, has been entered.

Response to Arguments

- 2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 3. Applicant's response to Office action was received on September 18, 2006.
- 4. All of the rejections from the previous Office action are hereby withdrawn. Note, however, that there is a new set of rejections and objections presented in this Office action below.

Claim Objections

- 5. Claims 1, 4, 8-10, and 12 are objected to because of the following informalities:
- a. In the last line of claim 1, please replace each of the two occurrences of the word "indicia" with --indicium--.
- b. In the second line of claim 4, please replace the phrase "alpha numeric" with the word --alphanumeric--.
- c. In the fourth line of claim 4, please replace the phrase "alpha numeric" with the word alphanumeric--.

- d. In the second-to-last line of claim 4, please replace the phrase "a time" with --identify a time--.
- e. In the second line of claim 8, please replace the phrase "alpha numeric" with the word --alphanumeric--.
- f. In the second-to-last line of claim 8, please replace the phrase "a time" with --identify a time--.
- g. In the fifth line of claim 9, please replace the phrase "information based" with -- information-based--.
- h. In the sixth line of claim 9, please replace the phrase "indicia postage" with --postage indicia--.
- i. In the eleventh line of claim 9, please replace the phrase "information based" with -- information-based--.
- j. In the eleventh and twelfth lines of claim 9, please replace the phrase "indicia postage" with --postage indicia--.
- k. In the twelfth line of claim 9, please replace the phrase "information based" with -- information-based--.
- l. In the thirteenth line of claim 9, please replace the phrase "information based" with -- information-based--.
- m. In the fourteenth line of claim 9, please replace the phrase "information based" with --information-based--.

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n. In the third-to-last and second-to-last lines of claim 9, please replace the phrase "the void information based postage indicia bearing" with --the void information-based-postage-indicia-bearing--.

- o. In the second-to-last and last lines of claim 9, please replace the phrase "non-void information based postage indicia bearing" with --non-void information-based-postage-indicia-bearing--.
- p. In the second line of claim 10, please replace the phrase "alpha numeric" with -- alphanumeric--.
 - q. In the third line of claim 10, please replace the word "therefor" with --therefore--.
- r. In the second line of claim 12, please replace the phrase "alpha numeric" with -- alphanumeric--.
 - s. In the third line of claim 12, please replace the word "therefor" with --therefore--.
- t. In the fourth and fifth lines of claim 12, please replace the phrase "a time of" with -- identify a time of--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claims 5, 9, and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per <u>Claim 5</u>, in the fourth and fifth lines of claim 5, the phrase "a first designated indicium" appears. This phrase also occurs in the second and third lines of claim 5. It is unclear if the same or a different "first designated indicium" is being referred to.

As per <u>Claim 9</u>, in the fifteenth and sixteenth lines of claim 9, the phrase "a first designated indicium" appears. This phrase also occurs in the second and third lines of claim 9. It is unclear if the same or a different "first designated indicium" is being referred to.

As per <u>Claim 11</u>, in the sixth and seventh lines of claim 11, the phrase "a first designated indicium" appears. This phrase also occurs in the third line of claim 11. It is unclear if the same or a different "first designated indicium" is being referred to.

As per <u>Claim 11</u>, Claim 11 recites the limitation "the stored data" in the third-to-last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

As per <u>Claim 12</u>, Claim 12 recites the limitation "the void mail piece" in the fourth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

As per <u>Claim 12</u>, Claim 12 recites the limitation "the void mail handling" in the second-to-last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Sievel et al., U.S. Patent No. 4,780,835.

As per Claim 11, Sievel et al. discloses:

- a postage indicium fraud detection method for permitting the automated processing, identification, and segregation of void mail pieces for which accounting has not been affected bearing a first designated indicium (Figure 3A; column 2, lines 34-49; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65);
- sorting mail based on indicia placed on mail pieces using automated mail handling equipment (Figure 3A; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; indicia are POSTNET barcodes);
- using client software to print a first designated indicium on a mail piece or a label to be applied to a mail piece, the first designated indicium comprising a designated postal numeric encoding technique (POSTNET) barcode that comprises a plurality of vertical bars, which designated POSTNET barcode does not correspond to an actual zip code (Figure 1; Figure 3A; column 2, lines 34-49; column 2, line 53, through column 3, line 21; column 3, line 39, through column 4, line 10; column 5, lines 26-60; column 7, line 60, through column 9, line 20; column 9, lines 60-65; barcode 47a in Figure 3A is a POSTNET barcode; user system acts like a client with respect to central station system, for example, when it requests more postage);

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- comparing the first designated indicium on the mail piece with the stored data and using the automated mail handling equipment to segregate mail pieces bearing the first designated indicium from mail pieces not bearing the designated indicium (Figure 3A; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; postal system would necessarily have to have information stored that indicates which markings are valid and which are not valid).

Claim Rejections - 35 USC § 103

9. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al. in view of Whitehouse, U.S. Patent No. 5,319,562.

As per Claims 1 and 5, Sievel et al. discloses:

- a postage indicium fraud detection method for permitting the automated processing of void mail pieces for which accounting has not been affected bearing a (first) designated indicium (using existing automated mail handling equipment) (Figure 3A; column 2, lines 34-49; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65);
- for cases where accounting for postage on a mail piece has not been affected, printing a first designated indicium on the mail piece or a label to be applied to the mail piece, the first designated indicium comprising a designated postal numeric encoding technique (POSTNET) barcode that comprises a plurality of vertical bars, which designated POSTNET barcode does not correspond to an actual zip code (or is different from a valid POSTNET barcode that corresponds to an actual zip code), which first designated indicium identifies the mail piece as being a void

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mail piece (which is to be sorted from mail pieces not bearing the designated indicium) (Figure 3A; column 2, lines 34-49; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; barcode 47a in Figure 3A is a POSTNET barcode);

- providing automated mail handling equipment that reads markings, and storing data concerning (or that identifies) the designated (or valid) markings (column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; postal system would necessarily have to have information stored that indicates which markings are valid and which are not valid);

- wherein the markings read by automated mail handling equipment are POSTNET barcodes (Figure 3A; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; barcode 47a in Figure 3A is a POSTNET barcode);

- (processing the void mail piece bearing the first designated indicium with the automated mail handling equipment by) using the automated mail handling equipment to read the first designated indicium (the POSTNET barcode) on the mail piece and compare it to the stored data and sort the void mail piece bearing the first designated indicia from mail pieces not bearing the first designated indicia (or if the read POSTNET barcode is not valid, identifying such mail piece as being a void mail piece, and segregating the void mail piece from other non-void mail pieces) (Figure 3A; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; barcode 47a in Figure 3A is a POSTNET barcode; postal system would necessarily have to have information stored that indicates which markings are valid and which are not valid).

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Sievel et al. fails to disclose wherein the markings read by automated mail handling equipment are FIM marking(s). Whitehouse discloses wherein the markings read by automated mail handling equipment are FIM marking(s) (column 1, line 27, through column 2, line 29; column 8, line 56, through column 9, line 30; column 12, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. such that the markings read by automated mail handling equipment are FIM marking(s), as disclosed by Whitehouse. Motivation is provided by Whitehouse in that FIM markings can be used to sort and route mail (column 1, line 27, through column 2, line 29; column 8, line 56, through column 9, line 30; column 12, lines 1-7).

10. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al. in view of Whitehouse in further view of Anonymous, "USPS Tries New Letter Tracking System," Resource, St. Joseph, May 2000, p. 15.

As per <u>Claims 4 and 8</u>, Sievel et al. and Whitehouse fail to disclose wherein an additional indicium (or second designated indicia) comprising a designated postal alpha numeric encoding technology barcode is printed onto the mail piece or label for the mail piece, which designated postal alpha numeric encoding technology barcode is used (by automated mail handling equipment) to identify a sender of the mail piece. Anonymous discloses wherein an additional indicium (or second designated indicia) comprising a designated postal alpha numeric encoding technology barcode is printed onto the mail piece or label for the mail piece, which designated postal alpha numeric encoding technology barcode is used (by automated mail handling equipment) to identify a sender of the mail piece (Section A). It would have been

obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified in the rejection for claims 1 and 5 such that an additional indicium (or second designated indicia) comprising a designated postal alpha numeric encoding technology barcode is printed onto the mail piece or label for the mail piece, which designated postal alpha numeric encoding technology barcode is used (by automated mail handling equipment) to identify a sender of the mail piece, as disclosed by Anonymous. Motivation is provided by Anonymous in that a PLANET code is effective at identifying the sender of a mail piece (Section A).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al. in view of Pierce et al., U.S. Patent No. 6,680,783 B1, in further view of Whitehouse.

As per <u>Claim 9</u>, Sievel et al. discloses:

- a postage indicium fraud detection method for permitting the automated processing and segregation of void mail pieces bearing a first designated indicium from non-void mail pieces not bearing the first designated indicium for which accounting has not been affected (Figure 3A; column 2, lines 34-49; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65);
- entering a valid delivery address, and selecting a mail class by the user (Figure 1; column 3, line 39, through column 4, line 10; column 6, lines 21-41; column 7, line 60, through column 8, line 2);
- wherein the void mail piece or the label therefore is printed with a first designated indicium comprising a designated postal numeric encoding technique (POSTNET) barcode that

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comprises a plurality of vertical bars, which designated POSTNET barcode does not correspond to an actual zip code, which first designated indicium identifies the mail piece as a void mail piece (Figure 3A; column 2, lines 34-49;-column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; barcode 47a in Figure 3A is a POSTNET barcode);

- providing automated mail handling equipment, and storing data that identifies the designated marking as corresponding to a void mail piece, which automated mail handling equipment is adapted to identify the first designated indicium on the mail piece and compare it to the stored data and segregate the void mail pieces from non-void mail pieces (Figure 3A; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; postal system would necessarily have to have information stored that indicates which markings are valid and which are not valid).;

- wherein the marking identified by the stored data is a POSTNET barcode (Figure 3A; column 2, line 53, through column 3, line 21; column 7, line 60, through column 9, line 20; column 9, lines 60-65; barcode 47a in Figure 3A is a POSTNET barcode).

Sievel et al. fails to disclose authorizing client software for a user to print information based indicia postage onto a mail piece or a label for a mail piece. Pierce et al. discloses authorizing client software for a user to print information based indicia postage onto a mail piece or a label for a mail piece (column 2, line 54, through column 3, line 16; column 3, line 66, through column 4, line 54; Host PC acts as a client with respect to Postal Service or postal authenticating vendor with which it communicates for recharging postage funds). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the

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invention of Sievel et al. such that it authorizes client software for a user to print information based indicia postage onto a mail piece or a label for a mail piece, as disclosed by Pierce et al. Motivation is provided by Pierce et al. in that information-based indicia technology is expected to support new methods of applying postage (column 1, lines 26-39).

Sievel et al. fails to disclose verifying and accepting the address and any modifications thereto. Pierce et al. discloses verifying and accepting the address and any modifications thereto (column 1, lines 26-59; column 2, lines 20-33; column 2, line 54, through column 3, line 16; the Host provides standardized addresses; the Host verifies each address at the time of mail piece creation). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified above in this rejection such that it verifies and accepts the address and any modifications thereto, as disclosed by Pierce et al. Motivation is provided by Pierce et al. in that verification and standardization of addresses is a requirement for IBIP open systems, and IBIP technology is expected to support new methods of applying postage (column 1, lines 26-59; column 2, lines 20-33; column 2, line 54, through column 3, line 16).

Sievel et al. fails to disclose selecting between printing a sample void information based indicia postage and a non-void information based postage indicia. Pierce et al. discloses selecting between printing a sample void information based indicia postage and a non-void information based postage indicia (Figure 3; Figure 4; column 2, line 54, through column 3, line 16; column 5, line 30, through column 6, line 30; indicates that sample envelope can be printed in column 5, lines 30-31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified above in this

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rejection such that it selects between printing a sample void information based indicia postage and a non-void information based postage indicia, as disclosed by Pierce et al. Motivation is provided by Pierce et al. in that a sample information-based postage indicium is useful for preview purposes while an actual information-based postage indicium is useful for actually evidencing postage payment (column 2, line 54, through column 3, line 16; column 5, line 30, through column 6, line 30).

Sievel et al. fails to disclose printing a sample void information based postage indicia for void mail pieces and printing non-void information based postage indicia for non-void mail pieces. Pierce et al. discloses printing a sample void information based postage indicia for void mail pieces and printing non-void information based postage indicia for non-void mail pieces (Figure 3; Figure 4; column 2, line 54, through column 3, line 16; column 5, line 30, through column 6, line 30; indicates that sample envelope can be printed in column 5, lines 30-31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified above in this rejection such that it prints a sample void information based postage indicia for void mail pieces and prints non-void information based postage indicia for non-void mail pieces, as disclosed by Pierce et al.

Motivation is provided by Pierce et al. in that a sample information-based postage indicium is useful for actually evidencing postage payment (column 2, line 54, through column 3, line 16; column 5, line 30, through column 6, line 30).

Sievel et al. fails to disclose wherein a mail piece is an information based postage indicia bearing mail piece. Pierce et al. discloses wherein a mail piece is an information based postage indicia bearing mail piece (column 2, line 54, through column 3, line 16; column 3, line 66, through column 4, line 54). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified above in this rejection such that a mail piece is an information based postage indicia bearing mail piece, as disclosed by Pierce et al. Motivation is provided by Pierce et al. in that information-based indicia technology is expected to support new methods of applying postage (column 1, lines 26-39).

Sievel et al. and Pierce et al. fail to disclose wherein the marking identified by the stored data is an FIM marking. Whitehouse discloses wherein the marking identified by the stored data is an FIM marking (column 1, line 27, through column 2, line 29; column 8, line 56, through column 9, line 30; column 12, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified above in this rejection such that the marking identified by the stored data is an FIM marking, as disclosed by Whitehouse. Motivation is provided by Whitehouse in that FIM markings can be used to sort and route mail (column 1, line 27, through column 2, line 29; column 8, line 56, through column 9, line 30; column 12, lines 1-7).

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al. in view of Pierce et al. in further view of Whitehouse in further view of Anonymous.

As per <u>Claim 10</u>, Sievel et al., Pierce et al., and Whitehouse fail to disclose printing a postal alpha numeric encoding technology barcode onto the mail piece or label therefore which is used by automated mail handling equipment to identify a sender of the void mail piece.

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Anonymous discloses printing a postal alpha numeric encoding technology barcode onto the mail piece or label therefore which is used by automated mail handling equipment to identify a sender of the void mail piece (Section A). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. as modified in the rejection for claim 9 such that it prints a postal alpha numeric encoding technology barcode onto the mail piece or label therefore which is used by automated mail handling equipment to identify a sender of the void mail piece, as disclosed by Anonymous. Motivation is provided by Anonymous in that a PLANET code is effective at identifying the sender of a mail piece (Section A).

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al. in view of Anonymous.

As per Claim 12, Sievel et al. fails to disclose wherein the client software is adapted to generate a postal alpha numeric encoding technology barcode, which when printed on a mail piece or label therefore is used by automated mail handling equipment to identify a sender of the void mail piece. Anonymous discloses wherein the client software is adapted to generate a postal alpha numeric encoding technology barcode, which when printed on a mail piece or label therefore is used by automated mail handling equipment to identify a sender of the void mail piece (Section A). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Sievel et al. such that the client software is adapted to generate a postal alpha numeric encoding technology barcode, which when printed on a mail piece or label therefore is used by automated mail handling equipment to identify a sender

of the void mail piece, as disclosed by Anonymous. Motivation is provided by Anonymous in that a PLANET code is effective at identifying the sender of a mail piece (Section A).

Conclusion

- 14. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.
- 15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Erb Examiner Art Unit 3628

nhe

JOHN W. HAYES V